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EXAMINER

PIKE, A

ART UNIT

PAPER NUMBER

3651

18

DATE MAILED:

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/083,422

Applicant(s)

Clare et al.

Examiner

Andrew C. Pike

Group Art Unit

3651



☒ Responsive to communication(s) filed on Jul 21, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-5, 7, 10-12, 14, 24-28, and 30-48 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-5, 7, 10-12, 14, 24-28, and 30-48 is/are rejected.

☒ Claim(s) 10 and 11 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on May 22, 1998 is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Priority

1. Applicants' claim for priority for receiving the benefit under 35 U.S.C. § 120 to prior U.S. applications Serial Nos. 08/910,516, 08/685,678, and 08/506,893 is acknowledged.

Oath/Declaration

2. Receipt of the supplemental oath or declaration filed January 8, 1999, is acknowledged.

Claim Objections

3. Claims 10 and 11 are objected to because of the following informalities:

The word "a" in claim 10, line 3, should be "an".

Appropriate correction is required.

Claim Rejections - Double Patenting

4. Claims 11 and 45 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 18 of U.S. Patent No. 5,823,598. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the mere variation of non-patentably distinct features in the claims.

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5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 C.F.R. § 3.73(b).

Claim Rejections - 35 U.S.C. § 102

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in the prior Office action.

7. Claims 1-5, 7, 25-28, 31-33, 35, 36, 38, 39, 43, 44, 47, and 48 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Ward.

Claim Rejections - 35 U.S.C. § 103

8. Claims 10 and 41 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ward in view of Bump.

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Ward clearly discloses almost all of the claimed features of the hidden storage system in the conventional bed of the conventional pickup truck having the hinged side panels and a storage box on each side (see paragraph 7 above), but lacks a strut assembly.

Bump discloses a bed of a pickup truck having side panels, and a storage system comprising a storage box mounted on each side of the pickup truck at least partially covering a wheel well and having an opening adjacent one of the side panels, and a portion of one of the side panels of each side of the pickup truck being horizontally hinged and having a lock and latch mechanism, and a strut assembly.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Ward to include a strut assembly, as taught by Bump, because the strut assembly would help hold the hinged panel portion open (Bump, column 3, lines 37-58).

9. Claims 12, 30, 34, and 42 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ward in view of Ogilvie, 1966, and Brindle.

Ward clearly discloses almost all of the claimed features of the hidden storage system in the conventional bed of the conventional pickup truck having the hinged side panels and a

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storage box on each side (see paragraph 7 above), but, for each storage box, lacks a plurality of horizontally hinged sections.

Ogilvie, 1966, clearly discloses a bed of a pickup truck having side panels, and a storage system comprising a storage box mounted on each side of the pickup truck covering a wheel well and having an opening adjacent one of the side panels, and a portion of one of the side panels of each side of the pickup truck being horizontally hinged and having an unexposed, hidden lock and latch mechanism, including hidden, mechanically activated latch members and a lock mechanism on each storage box, compartments, movable shelves, and a strut assembly.

Brindle clearly discloses a bed of a pickup truck having side panels, and a storage system comprising a storage box mounted on each side of the pickup truck and having an opening adjacent one of the side panels, and two portions of one of the side panels of each side of the vehicle being horizontally hinged and having a lock and latch mechanism, including mechanically activated latch members and a lock mechanism on each storage box, compartments, and shelves.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Ward to have, for each box, a plurality of horizontally hinged sections, as suggested and taught by Ogilvie, 1966, and Brindle, because having single or multiple portions being hinged is common

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for storage compartments (e.g., Ogilvie, 1966, and Brindle) and thus entails no more than routine skill in the art.

10. Claims 14 and 46 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ward in view of LeVee.

Ward clearly discloses almost all of the claimed features of the hidden storage system in the conventional bed of the conventional pickup truck having the hinged side panels and a storage box on each side (see paragraph 7 above), but lacks a drain/air relief valve assembly.

LeVee clearly discloses a bed of a pickup truck having side panels, and a storage system comprising a storage box mounted on each side of the pickup truck covering a wheel well and having an opening adjacent one of the side panels, and at least two portions of one of the side panels of each side of the pickup truck being horizontally hinged and having a lock and latch mechanism, compartments, shelves, and drain/air relief valve assembly located in a bottom section of the storage box thereof.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Ward to have a drain/air relief valve assembly, as taught by LeVee, because the drain/air relief valve assembly would prevent moisture condensation (LeVee, column 4, lines 15-17).

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11. Claim 24 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ward in view of Ogilvie, 1966.

Ward clearly discloses almost all of the claimed features of the hidden storage system in the conventional bed of the conventional pickup truck having the hinged side panels and a storage box on each side (see paragraph 7 above), but, for each storage box, lacks, *e.g.*, movable shelves.

Paragraph 9 above is incorporated by reference as to Ogilvie, 1966.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Ward to have, for each box, *e.g.*, movable shelves, as taught by Ogilvie, 1966, because the movable shelves would be adjustable (Ogilvie, 1966, column 3, line 28).

12. Claim 40 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ward.

Ward clearly discloses almost all of the claimed features of the hidden storage system in the conventional bed of the conventional pickup truck having the hinged side panels and a storage box on each side (see paragraph 7 above). As to the horizontally hinged sections being hinged at upper end sections thereof, this would be a mere reversal of orientation, *i.e.*, upwardly opening as opposed to downwardly opening, involving no

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more than routine skill in the art, and thus would have been obvious to one of ordinary skill in the art at the time the invention was made.

13. Claims 1-5, 7, 25-28, 31-33, 35-40, 43, 44, 47, and 48 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sisler in view of Ward.

Sisler discloses a hidden storage system in a conventional bed of a conventional pickup truck having the hinged side panels and a storage box on each side having an opening therein adjacent a side panel (column 3, lines 36-37) covering a wheel well and having compartments and a height less than that of the side panel, and constructed to not substantially alter an external appearance of a substantially identical pickup truck lacking the hidden storage system; but, for each side, lacks at least one side panel including a hinged section of the one side panel, and an unexposed, hidden latch mechanism and lock means.

Ward clearly discloses a hidden storage system in a conventional bed of a conventional pickup truck having side panels, which does not substantially alter an external appearance of the side panels when compared to side panels of a substantially identical bed, the hidden storage system comprising a storage box mounted on each side of the pickup truck covering a wheel well and having an opening adjacent one of the side panels, and a horizontally hinged portion of the one side panel on each

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side of the pickup truck, an unexposed, hidden, electrically activated latch mechanism and lock means on each storage box, compartments, and shelves.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Sisler to have, for each side, at least one side panel including a hinged section of the one side panel, and an unexposed, hidden latch mechanism and lock means, as suggested and taught by Ward, so as to form a swingable door into the storage box (Ward, column 3, lines 11-12) while substantially continuing the outward appearance of the bed (Ward, column 2, lines 1-20). As to the horizontally hinged sections being hinged at upper end sections thereof as recited in claim 40, this would be a mere reversal of orientation, *i.e.*, upwardly opening as opposed to downwardly opening, involving no more than routine skill in the art, and thus likewise would have been obvious.

14. Claims 10 and 41 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sisler in view of Ward as applied to claims 1 and 35 above, and further in view of Bump.

Sisler further lacks a strut assembly.

Paragraph 8 above is incorporated by reference as to Bump.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the

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system of Sisler, as modified by Ward, to include a strut assembly, as taught by Bump, because the strut assembly would help hold the hinged panel portion open (Bump, column 3, lines 37-58).

15. Claims 12, 30, 34, and 42 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sisler in view of Ward as applied to claims 1, 25, and 35 above, and further in view of Ogilvie, 1966, and Brindle.

Sisler further lacks, for each box, a plurality of horizontally hinged sections.

Paragraph 9 above is incorporated by reference as to Ogilvie, 1966.

Paragraph 9 above is incorporated by reference as to Brindle.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the system of Sisler, as modified by Ward, to have, for each box, a plurality of horizontally hinged sections, as suggested by Ogilvie, 1966, and Brindle, because having single or multiple portions being hinged is common for storage compartments (e.g., Ogilvie, 1966, and Brindle) and thus entails no more than routine skill in the art.

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16. Claims 14 and 46 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sisler in view of Ward as applied to claims 1 and 43 above, and further in view of LeVee.

Sisler further lacks a drain/air relief valve assembly.

Paragraph 10 above is incorporated by reference as to LeVee.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the system of Sisler, as modified by Ward, to include a drain/air relief valve assembly, as taught by LeVee, because the drain/air relief valve assembly would prevent moisture condensation (LeVee, column 4, lines 15-17).

17. Claim 24 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Sisler in view of Ward as applied to claim 1 above, and further in view of Ogilvie, 1966.

Sisler further lacks, e.g., movable shelves.

Paragraph 9 above is incorporated by reference as to Ogilvie, 1966.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Ward to have, for each box, e.g., movable shelves, as taught by Ogilvie, 1966, because the movable shelves would be adjustable (Ogilvie, 1966, column 3, line 28).

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Specification

18. The specification is objected to under 37 C.F.R. § 1.74 as failing to correctly identify the different parts shown in the figures by unique reference numerals required by 37 C.F.R.

§ 1.84(p)(4):

Reference numerals 103 and 104 each improperly identifies more than one feature (e.g., 103 on page 16, lines 4 and 6, should be 103' and 104 on page 16, line 6, should be 104', 103 on page 16, line 27, should be 303 and 104 on page 16, line 27, should be 304, etc.). The description of the modification shown in Fig. 12 improperly includes reference numerals of other embodiments. The description of the alternative embodiment shown in Fig. 14 improperly includes reference numerals of a different embodiment. The description of the alternative embodiment shown in Fig. 16 improperly includes reference numerals of a different embodiment.

Appropriate correction is required.

Drawings

19. The drawings are objected to under 37 C.F.R. § 1.84(p)(4) as failing to uniquely and correctly identify reference numerals:

Reference numerals 103 and 104 each improperly labels more than one feature (e.g., 103 and 104 in Fig. 10 should be 103' and

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104', etc.). The modification shown in Fig. 12 improperly includes reference numerals of other embodiments. The alternative embodiment shown in Fig. 14 improperly includes reference numerals of a different embodiment. The alternative embodiment shown in Fig. 16 improperly includes reference numerals of a different embodiment (i.e., 150, etc., in Fig. 16 indicates that the assembly shown therein is the same assembly as shown in Fig. 15, while page 22 of the specification describes it as a different assembly).

Correction is required.

20. The drawings are objected to under 37 C.F.R. § 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, "bulkhead section" (claim 28, line 2; this is not shown in any of Figs. 5-7) must be shown or the feature canceled from the claim. No new matter should be entered.

21. Applicants are required to submit a Proposed Drawing Correction in response to this Office Action, if the objection to the drawings is not otherwise overcome. Any proposal for amendment by the Applicants of the drawings to cure defects must include either:

- (a) a sketch in permanent black ink in compliance with 37 C.F.R. § 1.121(a)(3), showing
 - (1) the originally filed drawings with changes in red ink, or

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- (2) Proposed Substitute Drawings or Proposed Additional Drawings in black ink; or
- (b) new drawings in compliance with 37 C.F.R. § 1.84, including
 - (1) a sketch in permanent black ink showing the originally filed drawings with changes thereto in red ink in compliance with 37 C.F.R. § 1.121(a)(3)(ii), and
 - (2) new formal drawings correcting the noted defects.

This proposal should be a separate letter, i.e., drawings with a cover letter with an appropriate heading, e.g., "Proposed Drawing Correction", in compliance with 37 C.F.R. §§ 1.4(c) and 1.121(a)(3)(ii).

IMPORTANT NOTE: The filing of new formal drawings to correct the noted defects may be deferred until the application is allowed by the Examiner, but the sketch in permanent ink of the Proposed Drawing Correction is required in response to this Office Action, and may not be deferred unless the objection to the drawings is otherwise overcome.

Response to Arguments

22. Applicants' arguments with respect to the claims have been considered but are moot in view of the new grounds of rejection.

23. Applicants' arguments filed July 21, 1999, have been fully considered but they are not persuasive.

Applicants' reference to claim 8 of U.S. Patent No. 5,823,598 is incorrect. Note that the obviousness-type double patenting rejection is over claim 18 thereof.

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The present application is a continuation of Applicants' prior patented application Serial No. 08/910,516. Thus, grounds of objection remaining in the present application, corresponding to those in the prior patented application, are again objected to; and it is noted that presentation of amendments in the present application, corresponding to like amendments in the prior patented application which overcame the objections therein, would likewise overcome the objections stated hereinbefore.

Conclusion

24. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Examiner Andrew Pike whose telephone number is (703) 308-3423.

Any inquiry of a general nature, or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Correspondence related to this application may be transmitted by facsimile in accordance with 37 C.F.R. § 1.6, except for that correspondence for which facsimile transmission is prohibited under 37 C.F.R. § 1.6(d). Facsimile copies of an original signature under 37 C.F.R. § 1.4(d)(2) on correspondence transmitted by facsimile under 37 C.F.R. § 1.6 are acceptable. Applicants should retain the original correspondence papers as evidence of authenticity. If a question of authenticity arises, the Office may require submission of the original correspondence papers; BUT APPLICANTS SHOULD **NOT** SUBMIT THE ORIGINAL CORRESPONDENCE PAPERS IN ADDITION TO THAT TRANSMITTED BY FACSIMILE unless specifically required to by the Office. The

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Technology Center 3600 Fax Center facsimile number is (703) 305-7687.

Andrew C. Pike
7-29-1999
ANDREW C. PIKE
PRIMARY EXAMINER
ART UNIT 3651

acp
July 29, 1999